UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,523	10/07/2003	Ahmed F. Ghouri	ANVTA.001A	5056

20995 7590 11/12/2009

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER
LE, LINH GIANG

ART UNIT	PAPER NUMBER
3686	

NOTIFICATION DATE	DELIVERY MODE
11/12/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary	Application No.	Applicant(s)	
	10/680,523	GHOURI, AHMED F.	
	Examiner	Art Unit	
	MICHELLE LE	3686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 June 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to Amendment and Remarks filed 6/30/09. Claims 1, 6, 12, 22, 26, 30, 39, and 42 have been amended. Claims 1-48 remain pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The rejection of claims 1-5, 22-25, 30-38, and 39-41 is hereby withdrawn as Applicant has amended the claims to recite "one or more processors" to tie each of the claims to a "particular machine."

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The rejection of claims 1-48 under 35 USC 112, second paragraph, is hereby withdrawn in light of Applicant's amendments.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greenberg (2004/0039602) in view of Bodsworth (2002/0095314).

8. As per claim 1, Greenberg and Bodsworth collectively teach a method for the cost-effective use of medications, comprising:

adjusting, using one or more processors, the patient cost for at least one medication treatment therapy according to the cost-effectiveness of the medication treatment therapy (Greenberg; para. 32; Bodsworth; paras. 23, 24, 52); and

providing a physician with the adjusted patient cost of the medication treatment therapy (Bodsworth 61-63).

It would have been obvious to combine the teachings of Bodsworth and Greenberg with the motivation of decreasing the “knowledge deficit” in prescribing medicine (Bodsworth; Para. 7).

9. As per claim 2, Bodsworth teaches wherein adjusting the patient cost is based at least in part on patient medication treatment therapy history (Bodsworth; paras. 16 and 17).

10. As per claim 3, Greenberg teaches wherein adjusting the patient cost is based on at least one patient attribute (Greenberg; paras. 31 and 32).

11. As per claim 4, Greenberg teaches wherein the patient attribute includes at least one of: age, sex, weight, past and current medications, co-existing diseases, surgical history, allergies, laboratory findings, and social history (Greenberg; para. 21).

12. As per claim 5, Bodsworth teaches wherein the cost-effectiveness of the medication treatment therapy is based on the overall cost of treatment, including treatment of side-effects related to medication therapy (Bodsworth 61-63).

13. As per claim 6, Bodsworth and Greenberg teach a system for the cost-effective use of medications, comprising:
a user interface, configured to receive input from a user and display information (Greenberg; para. 23);
a cost-effectiveness analysis means, configured to determine a cost- effectiveness of a plurality of medication treatment therapies (Bodsworth; para. 61-63); and

a patient cost adjustment means, configured to adjust a patient cost for each of the medication treatment therapies according to cost-effectiveness data from the cost-effectiveness analysis means, wherein the adjusted patient cost for each medication treatment therapy is displayed on the user interface (Bodsworth; para. 61-63).

It would have been obvious to combine the teachings of Bodsworth and Greenberg with the motivation of decreasing the "knowledge deficit" in prescribing medicine (Bodsworth; Para. 7).

14. As per claim 7, Greenberg teaches wherein the cost-effectiveness of a medication treatment therapy is based at least in part on at least one patient attribute (Greenberg; paras. 31 and 32).

15. As per claim 8, Greenberg teaches wherein the patient attribute includes at least one of:
age, sex, weight, past medications, current medications, co-existing diseases, surgical history, allergies, laboratory findings, and social history (Greenberg; para. 21).

16. As per claim 9, Bodsworth teaches wherein the cost-effectiveness of a medication treatment therapy is based at least in part on the risk of complications for the medication treatment therapy (Bodsworth; paras. 61-63).

17. As per claim 10, Greenberg teaches wherein the plurality of medication treatment therapies are determined based on information provided at the user interface Greenberg; paras. 27 and 28).

18. As per claim 11, Greenberg teaches wherein the information provided at the user interface includes at least one of patient symptoms, diagnosis, and type of medication treatment therapy, whether by drug class, indication, or chemical structure (Greenberg; para. 23).

19. Claims 12-21; 22-25; 26-29; 30-38; 39-41; and 42-48 repeat substantially the same limitations as claims 1-11 and thus the claims are also rejected over Greenberg in view of Bodsworth under 35 USC 103(a). The reasons for rejection from above are incorporated herein.

Response to Arguments

20. Applicant's arguments filed 6/30/09 have been fully considered but they are not persuasive.

On pg. 9 of the 6/30/09 response, Applicant argues that Greenburg in view of Bodworth does not teach "adjusting, using one or more processors, a patient cost for at least one medication treatment therapy according to a cost effectiveness of the

medication treatment therapy." Examiner disagrees. Applicant on pg. 9 of the 6/30/09 Response discusses a "patient cost" as it is defined in the specification. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, claim language is subject to their broadest reasonable interpretation in light of the supporting disclosure. Thus, an interpretation of "patient cost" does not necessarily have to be confined to a "patient co-payment" as defined in the specification. Greenburg, para. 32, teaches a treatment approach based on a "cost of care." Examiner submits that a "cost of care" reads on a "patient cost" given a broad and reasonable interpretation of the limitation. The cost of caring for a patient is a "patient cost."

Furthermore, Bodsworth para. 52, teaches the limitation of "adjusting the patient cost." Bodsworth teaches a computer program that generates alternative prescriptions, allows a practitioner to choose an alternative prescription and then generates the cost savings (Bodsworth; paras. 61-63). Thus, Bodsworth reads on "adjusting the patient cost" by generating an alternative and providing a means for practitioner to choose the alternative prescription that will generate a cost savings.

Applicant also argues that Greenburg teaches away from the claimed invention because Greenburg teaches a billing module ensures third party regulations are met to allow a payment to a maximum extent. According to MPEP 2123, II, "[t]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from

any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed.." *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Thus Greenburg may teach an alternative to "adjusting the patient cost" in the billing module but does not criticize, discredit or discourage a system that adjusts the patient cost.

Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELLE LE whose telephone number is (571) 272-8207. The examiner can normally be reached on 8 AM - 5PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald O'Connor can be reached on (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/M. L./
Examiner, Art Unit 3686
11/3/09

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686